

**REMARKS****Summary of the Office Action**

Claims 17-21 stand rejected under 35 U.S.C. § 101 allegedly “because claims are directed to a computer data signal embodied in a carrier wave (air).”

Claims 1, 4, 7, 10, 12 and 15 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Tomoyuki Okada (U.S. Patent No. 6,148,140) (hereinafter “Okada”).

Claims 2, 3, 5, 8, 9, 11, 13, 14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Okada, in view of Mitsuyuki Nozaki (U.S. Patent No. 6,501,727) (hereinafter “Nozaki”).

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nozaki, in view of Shinich Kikuchi (U.S. Patent No. 6,553,180) (hereinafter “Kikuchi”).

**Summary of the Response to the Office Action**

Claims 1, 7 and 12 have been newly-amended to differently describe embodiments of the disclosure of the instant application. Claims 17-21 are canceled without prejudice or disclaimer. Accordingly, claims 1-16 remain pending for consideration.

**Rejection under 35 U.S.C. § 101**

Claims 17-21 stand rejected under 35 U.S.C. § 101 allegedly “because claims are directed to a computer data signal embodied in a carrier wave (air).” Applicants set forth a detailed traversal of this rejection in this previous response filed on July 25, 2006 in this application which still apply to these claims. Nevertheless, while Applicants do not concede to the

assertions in the Final Office Action, especially Examiner Chowhury's assertion that the "[c]laims are nothing but descriptive material," Applicants have canceled claims 17-21 without prejudice or disclaimer in light of the fact that the Examiner has made this rejection final.

Applicants provided a detailed explanation in the previous response as to why Applicants believe that these claims describe functional descriptive material and how the Interim Guidelines include specific directives in Annex IV that signal claims encoded with functional descriptive material are similar to a computer-readable memory encoded with functional descriptive material, thus seeming to clearly suggest that the USPTO contemplates that such signal claims might also be statutory. Nevertheless, in light of Applicants cancellation of these finally-rejected claims, the rejection has been rendered moot and withdrawal of the outstanding rejection is respectfully requested.

If, after reconsideration, Examiner Chowdhury realizes that this rejection should be withdrawn, the Examiner is authorized to reenter claims 17-21 by an Examiner's Amendment. Applicants believe that this action should be taken for at least the reasons previously filed on July 25, 2006 in this application in this regard.

**Rejections under 35 U.S.C. § 102(e) and 103(a)**

Claims 1, 4, 7, 10, 12 and 15 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Okada. Claims 2, 3, 5, 8, 9, 11, 13, 14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Okada, in view of Nozaki. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nozaki, in view of Kikuchi. Independent claims 1, 7 and 12 have been newly-amended to differently describe embodiments of the disclosure of the

instant application. To the extent that the Examiner might deem that these rejections still apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Applicants respectfully submit that in Okada, if VOB is added, information for the added VOB is added in the information in the RTRW. In other words, information for VOB is recorded in one area called RTRW. On the other hand, in embodiments of the disclosure of the instant application, Applicants respectfully submit that the tentative control information is recorded in an area different from an area where the managing control information is recorded. In other words, the managing control information is recorded, by using the tentative control information, in an area different from an area where the tentative control information is recorded.

Applicants respectfully submit that Okada does not record any information for VOB, by using the added information, in an area different from an area where the added information is recorded.

After the tentative control information is recorded in the area, the managing control information is generated by using the recorded tentative control information, and then the managing control information is recorded in an area different from the area where the tentative control information is recorded. That is, the managing control information includes at least a part of the same information as the tentative control information. This information is recorded doubly in the area where the managing control information is recorded and the area where the tentative control information is recorded.

Applicants respectfully submit that this is because the present invention has a feature that information is recorded in a recordable recording medium in conformity to a recording format for a recording medium for reproduction only. Applicants respectfully submit that at least these

features are not disclosed, taught, or suggested in any of the applied references. Therefore, the rejections should be withdrawn.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(e) and 103(a) should be withdrawn because the applied art of record, whether taken separately or in combination with each other does not teach or suggest each feature of independent claims 1, 7, and 12 of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Furthermore, Applicants respectfully assert that the dependent claims are allowable at least because of their dependence from independent claims 1, 7 and 12, and the reasons set forth above.

The additionally applied reference to Nozaki, with respect to claims 2, 3, 5, 8, 9, 11, 13, 14 and 16, does not cure the deficiencies discussed above with regard to Okada. Similarly, the additionally applied reference to Kikuchi, with regard to claim 6, does not cure the deficiencies discussed above with regard to Okada. In addition, the rejection of claim 6 under 35 U.S.C. § 103(a) is in question because it relies on only Nozaki and Kikuchi while claim 6 is dependent on claim 1, which is rejected with Okada. It follows that the rejection of claim 6 is possibly in error because it does not apply the art applied against the claim 6's independent claim 1.

The Applicants pointed out this issue regarding the possibly erroneous rejection of dependent claim 6 to the Examiner at the bottom of page 5 of the previously-filed response on July 25, 2007. However, the Examiner does not appear to have made any mention or response to the Applicants' inquiry in this regard. Instead, the Examiner has merely repeated this assertion against dependent claim 6 in the Final Office Action. In the event that this application is not passed to issuance after consideration of the foregoing remarks, Applicants respectfully request that finality of this Office Action be withdrawn in light of the fact that this argument has not been addressed, as per the directives of MPEP § 706.07 which states that "... the final rejection ... should include a rebuttal of any arguments raised in the applicant's reply (emphasis added)."

### **CONCLUSION**

In view of the foregoing discussion, Applicants respectfully request the entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including

any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**DRINKER BIDDLE & REATH LLP**

Dated: March 19, 2007

By:

A handwritten signature in black ink, appearing to read "Paul A. Fournier", written over a horizontal line.

Paul A. Fournier

Reg. No. 41,023

**Customer No. 055694**

**DRINKER BIDDLE & REATH LLP**

1500 K Street, N.W., Suite 1100

Washington, DC 20005-1209

Tel.: (202) 842-8800

Fax: (202) 842-8465